

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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CareerPhysician Advisors, LP

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Serial No. 88138743

Jerry C. Harris, Jr. of Wick Phillips Gould & Martin LLP,
for CareerPhysician Advisors, LP.

Tracy Whittaker-Brown, Trademark Examining Attorney, Law Office 111,
Chris Doninger, Managing Attorney.

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Before Wellington, Goodman and Lebow,
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

Applicant, CareerPhysician Advisors, LP, seeks registration of the mark PHYSICIAN TALENT OFFICER, in standard characters, on the Principal Register for use in connection with “Human resources consultancy; Consulting services in the fields of business management, human resources, and business organizational design” in International Class 35.¹

¹ Application Serial No. 88138743 was filed on October 1, 2018 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a bona fide intention to use the mark in commerce.

The Trademark Examining Attorney refused registration under § 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e), on the ground that the mark is merely descriptive of the identified services. When the refusal was made final, Applicant appealed. The appeal is fully briefed. We affirm the refusal.

I. Evidentiary Issue

Applicant, for the first time with its brief, provides two definitions as part of “Applicant’s Evidence”: one from BLACK’S LAW DICTIONARY (11th Ed. 2019) for the term “officer,” and one from the Internal Revenue Service (IRS) for the term “independent contractor.”² Applicant did not provide copies of the definitions, just website links. The Examining Attorney objects to this evidence and requests that the Board disregard it as untimely submitted during an appeal.”³

Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), provides that “[t]he record in an application should be complete prior to the filing of an appeal” and “[e]vidence should not be filed with the Board after the filing of a notice of appeal.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018), *aff’d*, 777 Fed. Appx. 516 (Fed. Cir. 2019). However, the Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

We will exercise our discretion to take judicial notice Applicant’s proffered

² 4 TTABVUE 7-8.

³ 6 TTABVUE 4.

definition from Black's Law Dictionary. *See In re North American Free Trade Association*, 43 USPQ2d 1282, 1285 n.6 (TTAB 1997) (judicial notice taken of definition from BLACK'S LAW DICTIONARY quoted in examining attorney's brief). However, we do not take judicial notice of the IRS definition because it is not actually a dictionary definition, but rather an explanation of a general rule for determining status under tax law. There is also no indication that the material is available in printed format.

II. Applicable Law

Section 2(e)(1) of the Trademark Act prohibits registration on the Principal Register of "a mark which, (1) when used on or in connection with the goods [or services] of the applicant is merely descriptive ... of them," unless the mark has been shown to have acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). A mark is "merely descriptive" within the meaning of § 2(e)(1) "if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought." *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). "A mark need not immediately convey an idea of each and every specific feature of the goods [or services] in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the goods [or services]." *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987)).

"It is well established that a term which describes the provider of goods or services

is also merely descriptive of those goods and services.” *In re Major League Umpires*, 60 USPQ2d 1059, 1060 (TTAB 2001). *See also In re Omaha Nat’l Bank*, 819 F.2d 1117, 2 USPQ2d 1859, 1861 (Fed. Cir. 1987) (rejecting argument that mere descriptiveness should be limited to a quality or characteristic of the goods or services themselves and holding that a designation may be merely descriptive of the provider of the goods or services). A mark that describes the provider of the subject goods and service need not also separately describe a feature or characteristics of the goods or services to be found merely descriptive, although it may do so. *Major League Umpires*, 60 USPQ2d at 1060.

Whether a mark is merely descriptive is “evaluated ‘in relation to the particular goods [or services] for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods [or services] because of the manner of its use or intended use,’” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *Bayer*, 82 USPQ2d at 1831), and “not in the abstract or on the basis of guesswork.” *Fat Boys*, 118 USPQ2d at 1513 (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)). We ask “whether someone who knows what the goods and services are will understand the mark to convey information about them.” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018) (quoting *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (internal quotation omitted)). A mark is suggestive, and not merely descriptive, if it requires imagination, thought,

and perception on the part of someone who knows what the goods or services are to reach a conclusion about their nature from the mark. *See, e.g., Fat Boys*, 118 USPQ2d at 1515.

We “must consider the commercial impression of a mark as a whole.” *Real Foods*, 128 USPQ2d at 1374 (quoting *DuoProSS*, 103 USPQ2d at 1757 (citation omitted)). “In considering [a] mark as a whole, [we] ‘may not dissect the mark into isolated elements,’ without ‘consider[ing] ... the entire mark.’” *Id.* (quoting *DuoProSS*, 103 USPQ2d at 1757). But we “may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its various components.” *Id.* (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004)). Indeed, we are “required to examine the meaning of each component individually, and then determine whether the mark as a whole is merely descriptive.” *DuoProSS*, 103 USPQ2d at 1758.

If the words in the proposed mark are individually descriptive of the identified goods and services, we must then determine whether their combination “conveys any distinctive source-identifying impression contrary to the descriptiveness of the individual parts.” *Fat Boys*, 118 USPQ2d at 1515-16 (quoting *Oppedahl & Larson*, 71 USPQ2d at 1372). If each word instead “retains its merely descriptive significance in relation to the goods [and services], the combination results in a composite that is itself merely descriptive.” *Id.* at 1516 (citing *In re Tower Tech., Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002)); *see also In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1953-55 (TTAB 2018).

“Evidence of the public's understanding of [a] term . . . may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers[,] and other publications.” *Real Foods*, 128 USPQ2d at 1374 (quoting *Royal Crown Co. v. The Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018)). “These sources may include [w]ebsites, publications and use ‘in labels, packages, or in advertising material directed to the goods [or services].’” *N.C. Lottery*, 123 USPQ2d at 1710 (quoting *Abcor Dev.*, 200 USPQ at 218).

III. Examining Attorney’s Evidence and Argument

The Examining Attorney relies on the following dictionary definitions of the words in the mark:⁴

- Officer: “One who holds an office of authority or trust in an organization, such as a corporation or government,” or “someone with a position of authority in an organization”;⁵
- Talent: “Natural endowment or ability of a superior quality; [a] person or group of people having such ability,” or a “person who possesses unusual innate ability in some field or activity”⁶; and
- Physician: “One who has a Doctor of Medicine,” or “a doctor; licensed medical practitioner.”⁷

The Examining Attorney also made of record a number of third-party registrations

⁴ 6 TTABVUE 5-6.

⁵ January 15, 2019 Office Action, TSDR 6-10 (American Heritage dictionary; MacMillan dictionary).

⁶ *Id.* at TSDR 11-15 (American Heritage dictionary; Vocabulary.com dictionary).

⁷ *Id.* at TSDR 16-20.

for marks that include the word OFFICER(S) either on the Principal Register (PR) with a disclaimer of that wording when used in connection with a business title, or on the Supplemental Register (SR) without a disclaimer, to show that the word is descriptive in the context of Applicant’s consulting services, including the following:⁸

Reg. No.	Mark	Relevant Services	Register
2729373	C.E.O. CHIEF ENVIRONMENTAL OFFICER (“CHIEF ENVIRONMENTAL OFFICER” disclaimed)	Management consulting in the field of environmental strategy	PR
3700543	MY SAFETY OFFICER	Management and business consulting services in the field of safety training	SR
3797866	CHIEF CUSTOMER OFFICER COUNCIL	Business consultation provided to those who hold the position of chief customer officers in their respective businesses	SR
4310846	CONTRACT MARKETING OFFICER	Business marketing services	SR
4443038	CHIEF HEALTH OFFICER MOM (“CHIEF HEALTH OFFICER” disclaimed)	Consulting services in the field of health	PR
4577826	CHARTER SCHOOL BUSINESS OFFICER CERTIFICATION	Consultation in the field of K-12 educational systems	SR
4797-22	STAND IN PRIVACY OFFICER	Regulatory compliance consulting in the field of data privacy and security	SR
5047171	FAMILY OFFICER	Financial consultancy	SR
4919881	EPRIVACY OFFICER	Consulting in the field of privacy and security laws, regulations and requirements	SR

⁸ July 22, 2019 Final Office Action, TSDR 7-63.

5494066	CHIEF LEADERSHIP OFFICER	Business training consultancy services	SR
5403757	TEXAS BEST LOAN OFFICER	Mortgage related consultancy	SR

Additionally, the Examining Attorney provided webpages from five websites, which she argues “establish[] the fact that TALENT OFFICER is a well-known term of art within the field of human resources,” including the following:

The people assuming the Chief Talent Officer role are often people who have demonstrated their business credentials, perhaps by running a business unit or by their involvements in product development or customer service. Many of them have also spent time building work teams, grappling with the internal people issues in teams and who have an understanding of the external trends and issues that are changing the nature of work and the ways people want to engage in work.

(ERE Media – ere.net)⁹

The Rise Of The Chief Talent Officer Many companies are strengthening their internal talent management capabilities with the chief talent officer role. This new leader in the C-suite is responsible for every aspect of human resources from the talent life cycle, managing internal recruitment teams, career development, employee engagement, succession planning and more. ... Chief talent officers need to implement initiatives catering to developing future generations of leadership

(Forbes – forbes.com)¹⁰

New Trends In HR: The Chief TALENT OFFICER. ... The world of human resources is in the midst of a fundamental shift. Gone are the days when hiring consisted of simply receiving resumes and conducting interviews: now, **talent management is the name of the game**. To reflect that, some organizations are hiring a Chief Talent Officer, or a senior executive who is tasked with managing talent relationships.

(Paycor – paycor.com)¹¹

⁹ *Id.* at 64-71.

¹⁰ *Id.* at 73-76.

¹¹ *Id.* at 80-82 (emphasis in original).

What is a Chief TALENT OFFICER? A Chief Talent Officer is in charge of the organizations internal and external talent acquisition strategy, especially for C-suite candidates (i.e. executives, managers and team leaders). This is a senior-level role aiming to create high-performance teams that help companies grow.

(Workable.com)¹²

The Examining Attorney also references another website to show that “medical professionals are referred to as TALENT”:

STRATEGIES FOR SECURING PHYSICIAN TALENT... In our annual Industry Survey, only 10% of CEOs described their organization’s physician recruitment and retention efforts as very strong and just 38% characterized as strong. Another 19% described it as weak or very weak. What trends are you seeing, and what are the actionable strategies to achieving an exceptional physician recruitment and retention program?

(HealthLeaders – healthleadersmedia.com)¹³

The Examining Attorney argues that “[t]he evidence establishes the wording TALENT OFFICERS is a term of art in the field of human resources, business management and business organizational design. Applicant finds or provides consultation regarding potential TALENT OFFICERS for its clients. The term TALENT on its own also refers to the individuals who are managed by TALENT OFFICERS. In this case, TALENT refers to a group of PHYSICIANS identified by the TALENT OFFICER as potential employees that possess the skill necessary for a particular assignment or job.”¹⁴

¹² *Id.* at 77.

¹³ *Id.* at 83-85.

¹⁴ 6 TTABVUE 8.

IV. Applicant's Arguments

In addition to the dictionary definitions provided by the Examining Attorney, as noted above, we take judicial notice of Applicant's proffered definition of "officer" from Black's Law Dictionary:

- Officer: Someone who holds an office of trust, authority, or command. In public affairs, the term refers esp. to a person holding public office under a national, state, or local government, and authorized by that government to exercise some specific function. In corporate law, the term refers esp. to a person elected or appointed by the board of directors to manage the daily operations of a corporation, such as a CEO, president, secretary, or treasurer.¹⁵

Based on the foregoing definition, Applicant argues that its consulting services "inherently preclude the Office Action's definition of 'Officer' from being descriptive of the services provided under the mark of the instant application – as a consultant would not be 'a person of authority and trust in an organization such as a corporation,' but rather a third-party contractor engaged to provide said organization or corporation a particular service."¹⁶ Since "[b]y law, an officer of a corporation is a statutory employee -- a consultant is an independent contractor. Accordingly, a consultant is not an employee; therefore, a consultant cannot meet the Office Action's definition of "Officer" for descriptive refusal purposes."¹⁷

Contending that hospitals, healthcare organizations and insurance companies are the relevant consumers or clients of Applicant's services, Applicant asserts that no

¹⁵ Black's Law Dictionary (11th ed. 2019).

¹⁶ 4 TTABVUE 5-6.

¹⁷ *Id.*

such company “would ever appoint/elect/hire a purely legal entity such as a limited partnership (as is the Appellant) ... with authority over the company.”¹⁸ “Moreover, “the “TALENT” suggested by the mark would certainly not be employees of the Appellant – rather would be employees of the Appellant’s clients.” “[T]here is simply no evidence in the record that indicates that the Appellant offers services directed to the hiring of managers of physician talent.”¹⁹

Applicant argues that the mark cannot be merely descriptive because “there is no instantaneous mental leap between PHYSICIAN TALENT OFFICER” and Applicant’s services because the services are “consultancy” and “consulting” and “PHYSICIAN TALENT OFFICER” does not provide an “instantaneous mental leap” to either “consultancy” or “consulting.”²⁰

V. Analysis and Discussion

Applicant essentially argues that the Examining Attorney has applied the wrong definition of “officer.”²¹ Coupling its proffered definition of “officer” as generally defined in corporate law with its contention that a consultant is an independent contractor under tax law, Applicant argues that “a consultant [such as Applicant’s consultant] is not an employee; therefore, a consultant cannot meet the Office Action’s

¹⁸ *Id.* at 11-12.

¹⁹ 7 TTABVUE 6-7.

²⁰ 4 TTABVUE 12.

²¹ *Id.* at 11-12.

definition of ‘Officer’ for descriptive refusal purposes.”²²

While the word “officer” has different meanings depending on the context, we must assess whether the proposed mark is descriptive “not in the abstract or on the basis of guesswork,” *Fat Boys*, 118 USPQ2d at 1513, but rather “in relation to the particular goods [and services] for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods [and services] because of the manner of its use or intended use.” *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219. Although Applicant focuses on the meaning of OFFICER in the corporate context and the tax consequences of a corporate officer that is an independent contractor, there is no evidentiary basis to interpret OFFICER in such a limited manner in this context. As noted above, the Examining Attorney provided definitions of “officer” as “one who holds an office of authority or trust in an organization, such as a corporation or government,” or “someone with a position of authority in an organization”.²³

We find that in the context of Applicant’s consultancy services, as confirmed by Applicant’s explanation of those services, the term TALANT OFFICER identifies Applicant as the provider of a services providing specialized talent, in particular PHYSICIAN talent: the provider is a PHYSICIAN TALENT OFFICER. Applicant’s argument that its consultants would not be persons of authority and trust as an

²² 4 TTABVUE 6-7. Although we did not take judicial notice of the IRS rule for determining when an individual is an “independent contractor,” we accept that it is common knowledge that the IRS establishes rules for determining tax status under the law.

²³ January 15, 2019 Office Action, TSDR 6-10 (American Heritage dictionary; MacMillan dictionary).

employee of its clients and therefore cannot be an “officer” as defined under tax law is unavailing. OFFICER, in this context, simply refers to “someone with a position of authority in [Applicant’s] organization.” *Id.*

Although unclear, Applicant’s contention that potential consumers would not use its services to hire or appoint an officer within their companies misses the point.²⁴ The fact that the word OFFICER “may have other meanings in different contexts is not controlling,” *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1597 (TTAB 2018), and, “[i]n any event, [i]t is well settled that so long as any one of the meanings of a term is descriptive, the term may be considered as merely descriptive.” *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1590 (TTAB 2018) (RECOIL found to “immediately convey information regarding the ability of [medical and athletic cohesive tape] to rebound or return to its original length or close to it” even though record contained six dictionary definitions of the word) (quoting *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984)). Even assuming that the word OFFICER in Applicant’s mark PHYSICIANS TALENT OFFICER only refers to Applicant as the provider, “a term which describes the provider of goods or services is also merely descriptive of those goods and services.” *Major League Umpires*, 60 USPQ2d at 1060; *In re Omaha Nat’l Bank*, 2 USPQ2d at 1861.

The third-party registration evidence shows that OFFICER is often disclaimed in marks registered on the Principal Register, or otherwise relegated to the Supplemental Register, when referring to a person that may be the provider of goods

²⁴ 4 TTABVUE 11-12.

or services.²⁵ Additionally, the evidence shows that TALENT OFFICER is a term of art to describe a person inside or outside an organization who is responsible for aspects of human resources including talent life cycle, employee engagement, and succession planning, or someone in charge of an organization's internal or external talent acquisition strategy.²⁶ All in all, the record establishes that an OFFICER, in the context of Applicant's services is a TALENT OFFICER, that is, someone in a position of authority in Applicant's company who identifies and consults with clients regarding possible employees for their organizations based on that consultant's abilities and knowledge in the field. That is their talent. Because the proposed mark is PHYSICIAN TALENT OFFICER and Applicant explains that its target consumers are hospitals, healthcare organizations, and insurance companies, the mark clearly describes Applicant's services of providing consultation regarding physician talent for companies.

Applicant argues that the mark is not merely descriptive because the services are "consultancy" and "consulting," and "PHYSICIAN TALENT OFFICER" does not provide an "instantaneous mental leap" to either "consultancy" or "consulting."²⁷ However, as the Examining Attorney observes, "[w]hether consumers could guess what the product [or services] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). "The question is not

²⁵ July 22, 2019 Final Office Action, TSDR 7-63.

²⁶ *Id.* at 73-82.

²⁷ 4 TTABVUE 12.

whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods and services are will understand the mark to convey information about them.” *DuoProSS*, 103 USPQ2d at 1757 (quoting *In re Tower Tech, Inc.*, 64 USPQ2d at 1316-17). We do not find that a mental leap is required to find mere descriptiveness. While Applicant focuses on, and cites case law pertinent to, the understanding of a mark with respect to the expression of attributes of the products identified in an application, as we have noted, a mark that merely describes the **provider** of services is also appropriately refused under Trademark Act § 2(e)(1). *Major League Umpires*, 60 USPQ2d at 1060; *In re Omaha Nat’l Bank*, 2 USPQ2d at 1861.

VI. Conclusion

We find that the terms PHYSICIAN and TALENT OFFICER in the proposed mark have a descriptive meaning with respect to Applicant’s human resources consultancy and consulting services in the field of human resources identified in the application, and that when combined as PHYSICIAN TALENT OFFICER, the wording “retains its merely descriptive significance in relation to the [services]” and “the combination results in a composite that is itself merely descriptive.” *Fat Boys*, 118 USPQ2d at 1516.

As Applicant notes, a descriptiveness refusal is proper “if the mark is descriptive of any of the [services] for which registration is sought.” *In re Chamber of Commerce*, 102 USPQ2d at 1219 (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005)). As addressed above, Applicant's proposed mark is merely

descriptive of Applicant as the provider of Applicant's human resources consultancy and consulting services in the field of human resources. Thus, the mark is merely descriptive and not entitled to registration on the Principal Register.

Decision: The refusal to register is affirmed.